

REMARKS

Reconsideration and allowance are respectfully requested.

Claims 1, 3-6, 8-9 and 11-14 are pending.

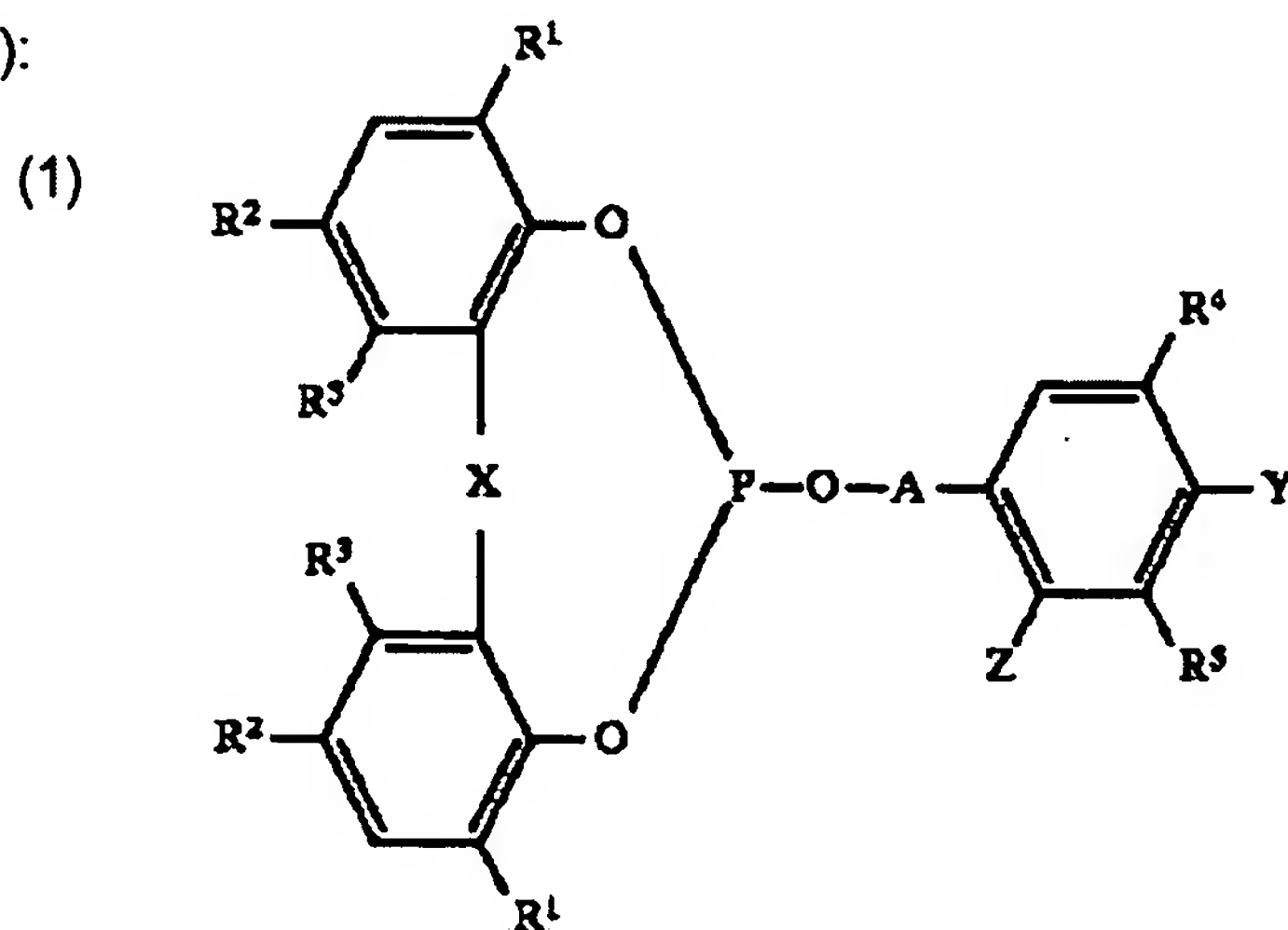
Remarks Regarding Section 102

A claim is anticipated only if each and every limitation as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of Calif.*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is claimed. See *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Claims 1 stand rejected under 35 U.S.C. § 102 as allegedly anticipated by Inue (U.S. Patent no. 5,889,095). Applicants traverse.

According to the Examiner:

Inue et al. discloses a phosphite stabilizer for organic material represented by the following formula (1):

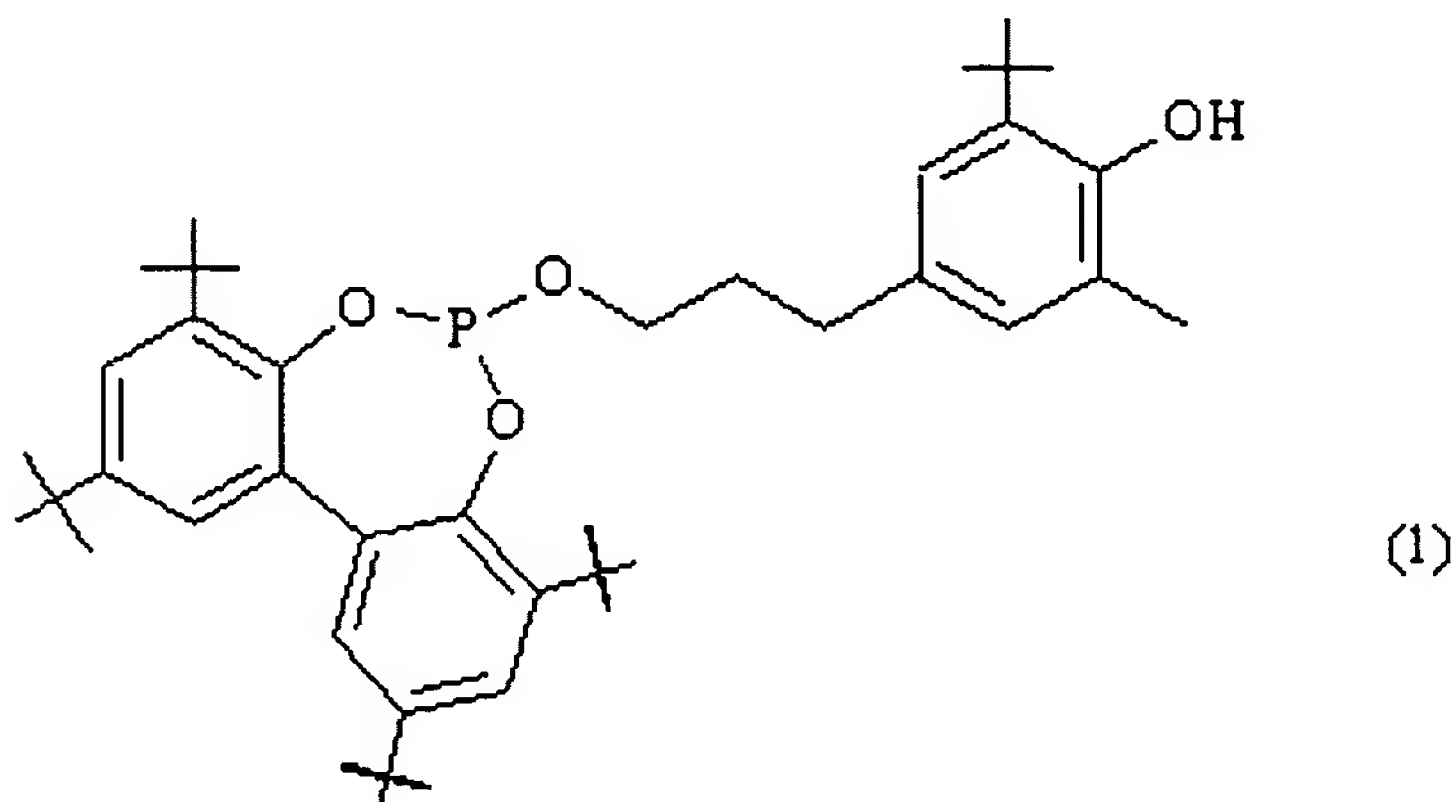


Wherein R¹, R², R⁴, and R⁵ can be an alkyl; R³ is hydrogen; X is a direct bond; A is an alkylene group having 2 to 8 carbon atoms; and one of Y and Z represent a hydroxyl (col1,line65-col2, line33).

An alkylene, as stated above for Inue's structure, comprises at least one carbon double bond.

In contrast to Inue, Applicants claimed invention, as recited in pending claim 1, is directed to radiation-curable resin composition comprising

(A) a compound of formula (1):



Applicants note that the claimed structure does not have a carbon double bond in the region defined as “A” in Inue. In other words, the claimed chemical structure contains an alkyl group while Inue’s structure has an alkylene group. Since the two chemical structures are different, there can be no anticipation.

Withdrawal of the Section 102 rejection is requested because Inue fails to disclose all limitations of the claimed invention.

Remarks Regarding Section 103

A claimed invention is unpatentable if the differences between it and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art. *In re Kahn*, 78 USPQ2d 1329, 1334 (Fed. Cir. 2006) citing *Graham v. John Deere*, 148 USPQ 459 (1966). The *Graham* analysis needs to be made explicitly. *KSR v. Teleflex*, 82 USPQ2d 1385, 1396 (2007). It requires findings of fact and a rational basis for combining the prior art disclosures to produce the claimed invention. See *id.* (“Often, it will be necessary for a court to look to interrelated teachings of multiple patents . . . and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue”). The use of hindsight reasoning is impermissible. See *id.* at 1397

(“A factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon ex post reasoning”). Thus, a prima facie case of obviousness requires “some rationale, articulation, or reasoned basis to explain why the conclusion of obviousness is correct.” *Kahn* at 1335; see *KSR* at 1396.

Claims 3-6, 8, 9, 11 and 12 stand rejected under 35 U.S.C. § 103 as allegedly obvious in view of a combination of Shustack (U.S. Patent No. 5,146,531) and Inue (U.S. Patent 5,889,095). Applicants traverse.

The Examiner alleges that Shustack discloses the limitations of the claimed invention. The Examiner further states “[h]owever, Shustack fails to teach the specified organic phosphate stabilizer as required by instant formula (1).” See, Office Action, page 3, lines 18-20. It is the Examiner’s position that Inue provides the specified organic phosphate stabilizer. As stated above, Inue does not disclose formula (1) at least because Inue specifies that the chemical structure must contain an alkylene group while in the claimed invention contains an alkyl group. Since the Examiner admitted that Shustack is defective since it does not disclose formula (1) and Inue does not disclose formula (1), there can be no obviousness rejection because the references together do not disclose all the limitations of Applicants claimed structure.

Furthermore, Inue teaches away from Applicants claimed structure. Inue indicates, in column 1 lines 58-61 that an alkylene group is the basis of Inue’s invention by stating, “As a result, it has been found that specific cyclic phosphites having a carbonyl group or an alkylene group in place of the carbonyloxyalkylene group shows excellent stabilizing effect. Thus, the present invention has been accomplished” (emphasis added). Inue further states that the alkylene group may be “ethylene, propylene, butylene, pentamethylene, hexamethylene, octamethylene and 2,2-dimethyl-1,3-propylene. Among them, propylene is preferred” (Inue, col. 2, lines 51-55; emphasis added). Since the basis of Inue’s invention is the alkylene group, Inue teaches one of ordinary skill in the art away from Applicants structure which contains an alkyl group.

Withdrawal of the Section 103 rejection is requested because the claims would not have been obvious to one of ordinary skill in the art when this invention was made.

Claims 13 and 14 stand rejected under 35 U.S.C. § 103 as allegedly obvious in view of a combination of Bishop (U.S. Patent No. 6,714,712) and Inue (U.S. Patent 5,889,095). Applicants traverse.

The Examiner alleges that Bishop discloses the limitations of the claimed invention. The Examiner further states “[h]owever, Bishop et al. fails to teach the specified organic phosphate stabilizer as required by instant formula (1).” See, Office Action, page 5, lines 14-15. It is the Examiner’s position that Inue provides the specified organic phosphate stabilizer. As stated above, Inue does not disclose formula (1) at least because Inue specifies that the chemical structure must contain an alkylene group while in the claimed invention contains an alkyl group. Since the Examiner admitted that Bishop is defective since it does not disclose formula (1) and Inue does not disclose formula (1), there can be no obviousness rejection because the references together do not disclose all the limitations of Applicants claimed structure.

As stated in the previous section, Inue, in addition to not teaching the claimed structure, actually teaches against Applicants claimed structure.

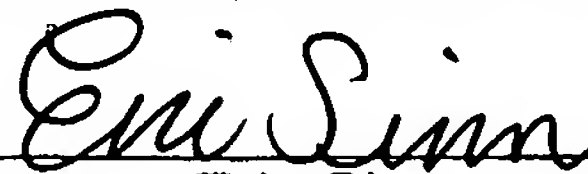
Withdrawal of the Section 103 rejections is requested because the claims would not have been obvious to one of ordinary skill in the art when this invention was made.

Conclusion

Having fully responded to the pending Office Action, Applicants submit that the claims are in condition for allowance and earnestly solicit an early Notice to that effect. The Examiner is invited to contact the undersigned if any further information is required.

Respectfully submitted,

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